

REMARKS

Claims 1-25 are currently pending in the application. The claims have not been amended in this paper but are provided in the above Listing of Claims for the convenience of the Examiner.

Rejections under 35 U.S.C. § 103

Claims 4-25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Menezes ('468) in view of Hill et al ('178) or Szilagyi et al ('278). Applicant respectfully requests reconsideration of the rejection.

With respect to independent claims 4 and 13, the Office Action conceded that Menezes does not show a "sound associated with aquatic prey" as claimed in claim 4, or a "sound of aquatic animals feeding" as claimed in claim 13. The Office Action therefore relied on Hill and Szilagyi to supply the omitted limitations. Applicant respectfully submits that a suggestion or motivation to modify Menezes by combining with Hill or Szilagyi is lacking. The suggestion or motivation must be found in the prior art and not based on hindsight or Applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Applicant respectfully submits that such a motivation or suggestion has not been provided in the cited references. When a motivation or suggestion to combine the teachings of the references is lacking, a *prima facie* case of obviousness has not been made. MPEP § 2142.

With respect to the dependent claims 5-12 and 14-25, Applicant respectfully requests reconsideration of the rejection. The Office Action summarily stated that "[d]ependent claims 5-12 and 14-25 are further provided by the combination of the above prior art." Claims 21-25, however, were added in the previous Amendment, and those claims have been rejected without

any specific explanation of the reasons why the claimed subject matter is obvious. In addition, Applicant is unable to find anywhere in the cited references a teaching or suggestion of the limitations of other dependent claims, such as "sweeping volume of playback within a selected range of volume levels" as claimed in claim 6, or "the step of gradually increasing the volume level of the signal up to a selected maximum volume level" as claimed in claim 16, *etc.*

Claims 1-3 were rejected under 35 U.S.C. § 103 based on Holt ('858) in view of Hill or Szilagyi. The Office Action stated that "Holt discloses a submersible device (see Fig. 9) for attracting and stimulating aquatic animals" with "a watertight housing (100), a first transducer element (135), and a diaphragm (140) connected to the diaphragm." Applicant, however, is unable to locate any Fig. 9, watertight housing 100, transducer element 135, or diaphragm 140 in Holt ('858); clarification is respectfully requested so that Applicant may fully respond to the Examiner's concern.

In addition, the Examiner stated that claim 3 is disclosed in Holt "since a fishing system inherently includes a flotation device." Applicant respectfully requests reconsideration of the rejection of claim 3. In relying upon a theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (reversing rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). Applicant respectfully submits that a basis in fact or technical reasoning to support the conclusion of inherency is lacking. Merely because a flotation device may be present in a fishing system is not sufficient to establish that a flotation device coupled to a housing is inherently present.

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In view of the above, Applicant respectfully submits that the claims are allowable over the cited references, and respectfully requests a Notice of Allowance at the earliest possible date.

Should the Examiner have any questions or concerns that can be addressed via telephone, the Examiner is requested to contact the undersigned representative at 512-473-2550, ext. 102.

Respectfully submitted,



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